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EXAMINER

PARA, ANNETTE H

ART UNIT

PAPER NUMBER

1661

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Please find below and/or attached an Office communication concerning this application or proceeding.

Application Number



Application No.

10/052,771

Examiner

Annette H. Para

Applicant(s)

SCHILLINGER ET AL.

Art Unit

1661

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Document

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2, 4-10, are drawn to plants and seeds that are resistant to at least two herbicides, classified in class 800, subclass 312.
- II. Claims 12-20 are drawn to soybean plants and seeds that are resistant to at least two herbicides, classified in class 800, subclass 312
- III. Claims 11, 21 are drawn to a soybean seed that is resistant to ALS inhibitor and glufosinate herbicides, classified in class 800, subclass 312.
- IV. Claims 11, 22 are drawn to a soybean seed that is resistant to glyphosate and glufosinate herbicides, classified in class 800, subclass 312.
- V. Claims 11, 23 are drawn to a soybean seed that is resistant to ALS inhibitor and isoxoflutoleherbicides, classified in class 800, subclass 312.
- VI. Claims 11, 24 are drawn to a soybean seed that is resistant to glyphosate and isoxoflutoleherbicides, classified in class 800, subclass 312.
- VII. Claims 11, 25 are drawn to a soybean seed that is resistant to glufosinate and isoxoflutole herbicides, classified in class 800, subclass 312.
- VIII. Claims 11, 26 are drawn to a soybean seed that is resistant to atrazine and ALS inhibitor herbicides, classified in class 800, subclass 312.
- IX. Claims 11, 27 are drawn to a soybean seed that is resistant to atrazine and glyphosate herbicides, classified in class 800, subclass 312.
- X. Claims 11, 28 are drawn to a soybean seed that is resistant to atrazine and glufosinate herbicides, classified in class 800, subclass 312.
- XI. Claims 11, 29 are drawn to a soybean seed that is resistant to atrazine and isoxoflutole herbicides, classified in class 800, subclass 312.
- XII. Claims 11, 30 are drawn to a soybean seed that is resistant to atrazine, ALS inhibitor and glyphosate herbicides, classified in class 800, subclass 312.

- XIII. Claims 11, 31 are drawn to a soybean seed that is resistant to atrazine, ALS inhibitor and glufosinate herbicides, classified in class 800, subclass 312.
- XIV. Claims 11, 32 are drawn to a soybean seed that is resistant to atrazine, ALS inhibitor and isoxoflutole herbicides, classified in class 800, subclass 312.
- XV. Claims 11, 33 are drawn to a soybean seed that is resistant to atrazine, glyphosate and glufosinate herbicides, classified in class 800, subclass 312.
- XVI. Claims 11, 34 are drawn to a soybean seed that is resistant to atrazine, glyphosate and isoxoflutole herbicides, classified in class 800, subclass 312.
- XVII. Claims 11, 35 are drawn to a soybean seed that is resistant to ALS inhibitor, glyphosate and glufosinate herbicides, classified in class 800, subclass 312.
- XVIII. Claims 11, 36 are drawn to a soybean seed that is resistant to ALS inhibitor, glyphosate and isoxoflutole herbicides, classified in class 800, subclass 312.
- XIX. Claims 11, 37 are drawn to a soybean seed that is resistant to ALS inhibitor, glufosinate and isoxoflutole herbicides, classified in class 800, subclass 312.
- XX. Claims 11, 38 are drawn to a soybean seed that is resistant to atrazine, glufosinate and isoxoflutole herbicides, classified in class 800, subclass 312.
- XXI. Claims 11, 39 are drawn to a soybean seed that is resistant to atrazine, ALS inhibitor, glyphosate and glufosinate herbicides, classified in class 800, subclass 312.
- XXII. Claims 11, 40 are drawn to a soybean seed that is resistant to atrazine, ALS inhibitor, glyphosate and isoxoflutole herbicides, classified in class 800, subclass 312.
- XXIII. Claims 11, 41 are drawn to a soybean seed that is resistant to ALS inhibitor, glyphosate, glufosinate and isoxoflutole herbicides, classified in class 800, subclass 312.
- XXIV. Claims 11, 42 are drawn to a soybean seed that is resistant to, glyphosate, ALS inhibitor glufosinate and isoxoflutole herbicides, classified in class 800, subclass 312.
- XXV. Claims 11, 43 are drawn to a soybean seed that is resistant to, atrazine, glyphosate, ALS inhibitor glufosinate and isoxoflutole herbicides, classified in class 800, subclass 312.

XXVI. Claims 44-49 are drawn to a method of introducing resistance to at least two herbicides into soybean plants and seeds by breeding, classified in class 800, subclass 260. (See election of species, if this group is selected).

Please note that claim 11 has been included with each of Groups II-XXV, and will be examined to the extent that it reads on the elected invention.

The inventions are distinct, each from the other because:

The invention of Group XXVI differs from the inventions of Groups I and II-XXV given that the method of Group XXVI can be used to make a different soybean seed or plant than those of Groups I and II-XXV, and the soybean seeds and plants of Groups I and II-XXV can be made by a different method than that of Group XXVI, such as by transformation. In addition, each of the soybean seeds of Groups II-XXV are different products that differ chemically and structurally and have different physiology in that they are each resistant to different combinations of herbicides and can each be made by different methods. Thus, the inventions of Groups I-XXVI are each capable of being separately made, independently used and the patentability of one would not render the other obvious or unpatentable.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: Claims 44-49 are drawn to methods of introducing resistance to combinations of different herbicides, wherein each requires a soybean variety having resistance to different classes of herbicides, which would differ chemically and structurally and have different physiological and morphological properties, wherein each method would be patentably distinct one from the other. Therefore, each method using a soybean seed having a particular herbicide resistance (ALS inhibitor and glufosinate of claim 21, for example) represents a distinct species of the claimed invention, which is patentably distinct.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 44 is generic.

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP §809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of the inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H. Para whose telephone number is (703) 308-6327. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campbell, can be reached on (703) 308-4205. The fax numbers for the group are Before Final (703) 872-9306 and After Final (703) 872-9307.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 872-9305.

A.H.P

A handwritten signature in black ink, appearing to read "Bruce Campell". The signature is fluid and cursive, with the first name "Bruce" and last name "Campell" clearly distinguishable.

BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600